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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,204	04/26/2000	DAVID REGAN	AND1P578	1516

29838 7590 10/28/2003

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EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,204

Applicant(s)

REGAN, DAVID

Examiner

James H Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/26/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller.

In regard to Claims 1, 6 and 11 Miller teaches an "electronic intermediary" which searches for taxpayers tax data (Col. 4, lines 54-56 compare to Claim 1 (and similarly Claims 6 and 11) *"retrieving tax-related forms in a database"*). Miller also teaches that the electronic intermediary processes the tax data (Col. 6, lines 42-52; compare to Claim 1 (and similarly to Claims 6 and 11) *"formatting the retrieved tax-related forms"*). Miller also teaches that the electronic intermediary electronically files the processed tax returns with the taxing authorities which in the case of the U.S. Internal Revenue Service (IRS) will correspond to the appropriate federal tax return such as the Form 1040 or the Form 1040EZ (Col. 6, lines 56-61; 62-64; compare to Claim 1 (and similarly Claims 6 and 11) *"sending formatted tax-related forms to a government entity, wherein the formatting is based on rules associated with the governmental entity"*).

In regard to dependent Claims 2, 7 and 12 Miller teaches that the "electronic intermediary" receives data from the taxpayer's brokerage firms, taxpayer's charities, taxpayer's other tax data providers, taxing authorities, taxpayer's banks, taxpayer's employers which can be stored by the electronic intermediary (Col. 5, lines 50-65; Fig.2 compare to Claim 2 (and similarly to Claims 7 and 12) "... *receiving updates to the tax-related forms, and storing the updates in the database*".

In regard to dependent Claims 3, 8 and 13 Miller teaches that the electronic intermediary electronically files the tax returns with the taxing authorities (Col. 6, lines 62-64 compare to Claim 3 (and similarly to Claims 8 and 13) "... *sending the retrieved tax-related forms to a processor utilizing a network for processing*".

In regard to dependent Claims 4, 9 and 14 Miller teaches that the electronic intermediary can receive processed data from any of the entities (see Fig. 2 compare to Claim 4 (and similarly to Claims 9 and 14) "... *the processed tax-related forms are received utilizing the network for storage in the database*".

In regard to dependent Claims 5, 10 and 15 Miller teaches an electronic data network such as the Internet is used by the electronic intermediary (Col. 3, lines 60-65; Col. 4, lines 51-54 compare to Claim 5 (and similarly to Claims 10 and 15) "... *the network is the Internet*".


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JHB


SANJIV SHAH
PRIMARY EXAMINER